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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,847	10/29/2003	Christiane Noeske-Jungblut	KOENIG-2-D1	4014

23599 7590 06/16/2005

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EXAMINER

ROOKE, AGNES BEATA

ART UNIT PAPER NUMBER

1653

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/694,847

Applicant(s)

NOESKE-JUNGBLUT ET AL.

Examiner

Agnes B Rooke

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 01 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 14-17 is/are pending in the application.
- 4a) Of the above claim(s) 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 14-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

Claims 1-11 and 14-17 are pending.

Claims 12 and 13 have been cancelled.

Applicant's election with traverse of Group I, Claims 1-10 and 14-17 in the reply filed on April 1, 2005 is acknowledged.

The traversal is on the ground that the PTO has not established that it would pose an undue burden to examine the full scope of the application. Examiner respectfully disagrees because the search of all the claims would constitute an undue burden on the examiner. Two separate searches must be performed because inventions of Group I and Group II are distinct since the polypeptides of Group I can be used in a materially different process such as generating antibodies, and thus the search required for Group I is not required for Group II. Further, each different peptide sequence is considered distinct one from the other on the basis of physical, chemical and biological properties and functions, and therefore an additional election of a peptide was properly required.

The restriction requirement is still deemed proper and is therefore made Final.

Claim 11 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected claims.

Claims 1-10 and 14-17 are currently under examination.

A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144).

***Prior Art Search Results***

Examiner performed search of the elected amino acid sequence (SEQ ID NO:3) by using the U.S. PTO search engine, and the elected sequence appears to be novel.

***Priority Data***

Applicant claims priority to a DIV application of 09/445,214, filed on 05/03/2000, now abandoned, which is a 371 of PCT/EP98/03356, filed on 06/05/1998. The foreign priority is given to GERMANY 197 24 791.1, filed on 06/06/1997.

***Specification***

On page 1 of the specification, in the first paragraph, the current continuation and priority data for the instant application must be provided.

The amendment to the specification filed on 10/29/2003 is acknowledged and it does not constitute a new matter.

***Drawings***

There is only one drawing and it does not have a title or assigned Figure number. Figure numbering must be consistent with the specification.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-10 and 14-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Since patents are not granted to products of nature, a peptide claimed must be isolated or purified. Thus, proper correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1-10 and 14-17 are rejected under 35 U.S.C. 112 second paragraph because they contain non elected subject matter in the claims.

***Conclusion***

No Claims are allowed.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Agnes Rooke whose telephone number is 571-272-2055. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status

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information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

AR

A handwritten signature in cursive script, reading "Karen Cochrane Carlson" followed by a stylized monogram or initials.

**KAREN COCHRANE CARLSON, PH.D**  
**PRIMARY EXAMINER**